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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,095	02/08/2001	Jean-Louis Gueret	08048.0032-00000	1674

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EXAMINER
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GHALI, ISIS A D

ART UNIT	PAPER NUMBER
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1611

MAIL DATE	DELIVERY MODE
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10/27/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 09/779,095	<b>Applicant(s)</b> GUERET, JEAN-LOUIS	
	<b>Examiner</b> Isis A. Ghali	<b>Art Unit</b> 1611	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 21 October 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 1,5,6,8-30 and 35-68.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
 13. ☐ Other: \_\_\_\_\_.

/Isis A Ghali/  
 Primary Examiner, Art Unit 1611

Continuation of 3. NOTE:

The claims as amended to recite "hair or skin" will require new search and further reconsideration.

Claims 1, 5, 6, 8-30, 35-68 remain rejected under 35 U.S.C. 112, first paragraph.

Claims 1, 5, 6, 8-11, 14-30, 35-60, 65-68 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sternfield et al. (US 2,665,528) in view with Smith (US 6,491,928).

Claims 12, 13, 61-64 remain rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sternfield and Smith and further in view of JP 04108710 ('710).

Applicant argues that each of independent claims 1, 27, and 54-56 recites "at least one moisture-absorbing compound configured to swell within the adhesive matrix upon contact with the solvent to reduce cohesion between the adhesive matrix and the at least one active agent." The final Office Action alleges that this feature is satisfied by Smith's alleged teaching of cellulose and starches that form hydrogels and, therefore, absorb water. Applicant argue that the present claims, e.g., claim 10, specify cellulose and starch broadly. There is no indication that Smith discloses the same type of cellulose or starches as Applicant. There is no suggestion that the properties of the cellulose and starches disclosed by Smith are identical to the properties of the cellulose and starches recited in Applicant's claims that would reduce cohesion between an adhesive matrix and at least one active agent, as required by independent claims 1, 27, and 54-56.

In response to this argument, it is argued that carboxymethyl cellulose and starch taught by Smith are hydrophilic polymers in nature and are capable to absorb water, see for example US 4,883,535, col.2, and lines 41-54. Applicant claimed cellulose and starch as compound configured to swell within the adhesive matrix upon contact with the solvent to reduce cohesion between the adhesive matrix and the at least one active agent, and Smith teaches cellulose and starches that form hydrogel, i.e. absorb water, and Smith teaches the same compounds to absorb water to form hydrogel. Applicants claims cellulose and starch in general which are taught by Smith. The hydrocolloids taught by Smith would display the same claimed properties since materials and their properties are inseparable. If the prior art meets the structure recited, the properties must be met or Applicant's claim is incomplete. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990) which holds that products of identical chemical composition can not have mutually exclusive properties. As such, it is the examiner's position that cellulose and starch in the composition advanced by Smith compositions enumerated in the instant claim set. It has been held that the failure of those skilled in the art to contemporaneously recognize a property, function, or ingredient of a prior art reference does not preclude the presence of these function.

Applicant maintains that there would not have been any suggestion to a person of ordinary skill in the art to combine the skin or hair cleansing article of Smith with the cleansing tissue of Sternfield that is evidently configured for scrubbing heavily- soiled surfaces, as opposed to body parts. Examiner has not set forth any such articulated reasoning or rational underpinning to support the legal conclusion of obviousness based on the proposed combination of Sternfield and Smith.

In response to this argument, applicant's attention is directed to the scope of the present claims that are directed to a product, and all the elements of the product are taught by the combination of the prior art. It is further argued that Smith teaching is not only directed to skin and hair as applicant alleged. Smith teaches an article for personal care application as well as for variety of other industries such as automotive care, marine vehicle care, house hold care, dish care, animal care, etc. where surfaces or areas are in need of cleansing and/or application of benefit agent, e.g. wax, conditioner, UV protectant, etc. (col.2, lines 5-10; col.19, lines 28-33). Smith however teaches articles for personal care as preferred embodiment. It has been held that the disclosed examples and preferred embodiment do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971 ). Therefore, one having ordinary skill in the art would have been motivated to combine Sternfield with Smith, and reasonable expectation to provide this invention exists as set forth in this office action.

Applicants further argue that Yoko is cited only for teaching of a "cosmetic in adhesive matrix comprising magnetizable particles, and fails to cure the above-noted deficiencies of Sternfield. Therefore, the cited art does not disclose or suggest all of the recited features of independent claim 61.

In response to this argument, as applicant admits, Yoko is cited solely for teaching of a "cosmetic in adhesive matrix comprising magnetizable particles". As stated before, the combination of Sternfield and Smith teaches article for cleansing skin or other hard surfaces, and based on the intended use, one having ordinary skill in the art would add magnetic particles. A conclusion of obviousness under 35 U.S.C. 103 (a) does not require absolute predictability, only a reasonable expectation of success; and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. *In re Bozek*, 163 USPQ 545 (CCPA 1969).